

REMARKS

Claims 14-24 were added by preliminary amendment and stand rejected. Claims 14, 18-21, 23, and 24 are amended without prejudice. Claims 15 and 17 are cancelled. Claims 26 and 27 are added. Claims 14, 16, and 18-27 are pending.

Objection to Specification:

The first paragraph of the specification is amended to recite the status of the parent application, as requested by the Examiner.

Support for the amendments to the Claims and for new Claims 26 and 27 is found in the specification and drawings. In particular, but without limitation, support for the amendments is found at pages 33, lines 3-31. It is respectfully urged that the spline and groove arrangement set forth in the specification supports mechanical coupling and decoupling of rotation of the cutter with respect to rotation of the piercer.

Claim 23 is amended to change the word "a ffect" to "e ffect". Claim 24 is amended to insert a space that what missing in the claim as originally presented.

102 Rejection:

The Examiner rejects all the claims as originally presented in the preliminary amendment for this divisional application as anticipated by US 5,980,469 to Burbank et al. It is respectfully urged that the '469 patent does not anticipate or suggest the present claims (as amended) for at least the reasons set for below.

With respect to Claim 14, as amended, it is respectfully urged that the '469 patent does not teach or suggest a device for automatically rotating a piercing element after severing of a sample with the cutter, wherein rotation of the piercing element is effected by rotation of the elongated cutter. Instead, it is respectfully urged that rotation of the piercer in the '469

patent is not effected by rotation of a cutter, but is instead provided by a separate drive mechanism, such as by a separate drive motor.

The '469 patent at column 8, line 66- column 9 discloses rotating the laterally disposed tissue port of the hollow tubular member to a predetermined angular orientation, and teaches at column 9, lines 14-24 that the hollow piercing needle can be mounted on a rotatable positioner for controlling the angular orientation of the tissue receiving port. The '469 patent teaches at column 10, lines 31-39 a proximal rotational drive controlling mechanism connected to the elongated primary hollow tube configured to rotate the elongate hollow tube to selected positions about the elongate hollow tube's long axis whereby the instrument can extract multiple intact samples radially from within a target lesion. The '469 patent also teaches at column 11, lines 18-25 rotating the lateral tissue receiving port to a predetermined angular orientation.

The '469 detailed description teaches in Columns 13 and 14 an outer needle 44 with a gear 48, a piercing needle drive motor 56 which meshes with gear 48, an inner cutter 68 with an indexing gear 72 and an inner cutter drive gear 76 attached to drive motor 80 and meshing with cutter indexing gear 76. A control unit 118 controls operation of drive motors 56, 80, 104 (knock out pin drive motor).

It is respectfully urged that the '469 patent does not teach a device for automatically rotating a piercing element after severing a tissue sample, where rotation of the piercing element is effected by rotation of the cutter. Instead, the '469 patent employs a piercing needle drive motor 56 for rotating the needle in the '469 patent. Accordingly, it is respectfully urged that '469 does not teach rotation of a piercing element effected by rotation of a cutter, and in particular, automatic rotation of a piercing needle after tissue severing where the rotation of the piercing needle is effected by rotation of the cutter.

The present application at page 33, lines 28-30 explains one advantage of effecting rotation of the piercer by rotation of the cutter.

With respect to Claim 18, as amended, it is respectfully urged that '469 does not teach or suggest a device as recited in Claim 14 and automatically rotating a piercing element after severing of a tissue sample and prior to retraction of the elongated cutter proximal of said port.

Likewise, with respect to Claim 19 as amended, it is respectfully urged that '469 does not teach automatic rotation of a piercing element that is effected by rotation of the elongated cutter when the distal cutting end of the elongated cutter is advanced distally of a tissue receiving port.

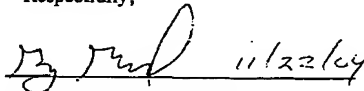
With respect to Claim 20, as amended, it is respectfully urged that '469 does not teach or suggest rotation of a cutter which is mechanically coupled to rotation of a piercing element when the elongated cutter is disposed in at least one position with respect to a port of the piercing element, and wherein rotation of the elongated cutter is decoupled from rotation of the piercing element when the elongated cutter is disposed in at least one different position with respect to the port.

It is respectfully urged that '469 does not teach or suggest the subject matter of Claims 21-27 for at least the reasons set forth above.

Double Patenting:

The Examiner is respectfully requested to hold the double patenting rejection in abeyance until allowable subject matter is identified.

Respectfully,

Handwritten signature of Gerry Gressel in black ink, with the date 11/22/04 written to the right of the signature.

Gerry Gressel, Reg. 34,342

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